

REMARKS

Claims 1 to 20 are pending in this application. In this Amendment, in response to the Office Action dated September 29, 2004, claims 2 to 5 have been cancelled, and claims 1, 8, 13 and 20 have been amended.

Claim 12 has been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of copending Application No. 10/222,634. Applicants disagree with this provisional rejection. Applicants assert that claim 12 of this application and claim 14 of the copending application are patentably distinct from one another.

The Office Action stated: that, although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are directed to three layers of coatings on a substrate – an electrodeposition coating, an intercoating and a top coat; that, when the intercoat of claim 12 cures, the blocking agent will be driven off and the resulting intercoat will be the same as that of claim 14 of the copending application; that claim 12 of this application differs from the copending claim by specifying a pigment in the intercoat; that it would be obvious to one of ordinary skill in the art at the time the invention was made to include a pigment because pigments are commonly included in coating formulations; and that this is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

In response, applicants note that both claim 12 of the present invention and claim 14 of copending Application No. 10/222,634 are directed to three layers of coatings on a substrate – that is, an electrodeposition coating, an intercoating and a top coat, as stated in the subject Office Action. However, the intercoat coating composition in claim 12 of the present invention contains as an essential component a blocked polyisocyanate curing agent blocked with a pyrazole blocking agent as claimed in amended claim 1 of the present invention. In contrast, the intercoat coating composition in claim 14 of the copending application contains as an essential component a blocked polyisocyanate curing agent as claimed in claim 1 of the copending application. The copending application discloses blocked polyisocyanate curing agents, such as, phenols, lactams, alcohols, ethers, oximes, and the like. Further, the copending application specifically discloses oxime blocking agents only as in Examples 1 through 7.

It should be noted that the copending application is silent about the pyrazole blocking agent as in amended claim 1 of the present invention. In connection therewith, the use of the oxime blocking agent shows poor anti-chipping properties compared with the pyrazole blocking agent, as is evident from a comparison between results of Example 1 and results of Comparative Example 1 in the present application, resulting in making it impossible to accomplish the present invention.

For these reasons, applicants assert that claim 12 of this application and claim 14 of the copending Application No. 10/222,634 are patentably distinct from one another. Thus, applicants assert that the provisional rejection of claim 12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of copending Application No. 10/222,634 should be withdrawn at present.

The Office Action stated: that applicant is advised that should claim 15 be found allowable, claim 16 will be objected to under 37 C.F.R. 1.75 as being a substantial duplicate thereof; that, when two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

Applicants note that, if claim 15 is found to be allowable, claim 16 will be deleted.

Claims 2, 8, 13, 17 and 20 have been objected to under 37 C.F.R. 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. In response, applicant notes that claim 1 has been amended accordingly in this application. Applicants assert that amended claim 1 is broader in scope than are the claims that depend from it.

The Office Action stated: that these claims are broader in scope than claim 1, which is limited to a blocking agent of pyrazole. Applicants assert that claim 1, as amended herein, is broader in scope than are the claims that depend from it.

In this Amendment, applicant amended claim 1. Applicants assert that, as amended, claim 1 is broader in scope than are the claims that depend from it. Thus, applicants assert that the objection to claims 2, 8, 13, 17 and 20 under 37 C.F.R. 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim, presently should be withdrawn.

Claims 1, 3, 4, 6, 7, 9, 12, 15 and 16 have been rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Melchior (2002/0165334). Applicants traverse this rejection.

The Office Action stated: that Melchior discloses non-yellowing (abstract) aqueous intercoats (para. #129) comprising polyester urethane polyols and dimethyl pyrazole blocked aliphatic polyisocyanates (see example D1); that, in paragraph 53, he discloses including pigments and fillers; that, when a reference discloses all the limitations of a claim except for a property, and the examiner can't determine if the reference inherently possesses the property (lightness index), the burden is shifted to the applicant as in *In re Fitzgerald*, 205 USPQ 594.

In response, applicants note the following: As stated in the Office Action, Melchior discloses non-yellowing (abstract) aqueous intercoats (para. #129) comprising polyester urethane polyols and dimethyl pyrazole blocked aliphatic polyisocyanates (see example D1), and, in paragraph 53, he discloses including pigments and fillers.

However, Melchior is silent about the intercoat coating composition containing as an essential component a hydroxyl group-containing polyester resin (A_2) containing as essential components an alicyclic polybasic acid (a_1) and/or an alicyclic polyhydric alcohol (a_2), another polybasic acid (a_3) and another polyhydric alcohol (a_4) as claimed in amended claim 1.

According to the presently claimed invention, the use of the specified hydroxyl group-containing polyester resin (A_2) containing the alicyclic polybasic acid (a_1) and/or the alicyclic polyhydric alcohol (a_2) makes it possible to particularly improve anti-chipping properties. It is evident from comparison between the results of Experiment Nos. 1 through 4 and those of Experiment Nos. 5 through 7 in the attached, executed declaration that the use of the specified hydroxyl group-containing polyester resin (A_2) containing the alicyclic polybasic acid (a_1) and/or the alicyclic polyhydric alcohol (a_2) of the subject invention makes it possible to particularly improve anti-chipping properties as compared both with hydroxyl group-containing polyester resins No. 3 and No. 4, and with urethane-modified hydroxyl group-containing polyester resin (Byhydrol PT241). These do not contain the alicyclic polybasic acid (a_1) and/or the alicyclic polyhydric alcohol (a_2).

In connection therewith, it seems impossible to use the aqueous intercoat to particularly improve VDA stone chip resistance as compared with the use of commercial polyester dispersion and commercial melamine resin. This is evident

from comparison between the results of Example A4 and those of Example A6 as in Melchiors.

For these reasons, applicants disagree that claims 1, 3, 4, 6, 7, 9, 12, 15 and 16 are either anticipated by or are obvious over Melchiors (2002/0165334). Thus, applicants assert that this rejection under 35 U.S.C. 102(e) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Melchiors (2002/0165334) should be withdrawn at present.

Claims 5, 10, 11, 14, 18 and 19 have been objected to for depending on rejected claims. Applicants believe that the claims as amended herein will overcome this rejection.

Reconsideration, reexamination and allowance of the claims and application are respectfully requested.

Respectfully submitted,

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